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CENTRAL FAX CENTER

Application No.: 09/992879

SEP 14 2008

Case No.: 56612US003

REMARKS

Reconsideration is requested.

Status of Claims

Claims 1-4, 6, 9-11, and 13 are currently pending and under examination. Claims 5, 7, 8, 12 and 14-37 were previously canceled. No claims are amended, nor are any new claims added in this Response.

§103 Rejection

Claims 1-4, 6, 9-11, and 13 stand rejected under 35 USC §103(a) as obvious over the three patent combination of U.S. Patent No. 5,744,295 (Pitt et al.), U.S. Patent No. 5,472,455 (Mehreteab et al.), and U.S. Patent No. 6,319,428 (Michot et al.).

Antistats are materials intended to prevent or inhibit the buildup of static electricity by bleeding off static electrical charges. Many compounds used as antistats comprise cations and anions that exhibit conductive and ionic properties. However, just because a selected cation and anion combination yields a compound which is conductive and ionic does not mean the compound is suitable for use as an antistat. Depending upon the application such parameters as solubility and matrix compatibility will be important. Also, acceptable performance is achieved only if the compound provides for decay of a static charge at an acceptable rate.

It is stated in the Office Action that "It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of anions and cations in a single invention". The rejection is based on a combination of three references in which cations and anions from Table 5 of the instant application were combined in different ways to provide surfactants and conductive additives. The basis of the rejection can be paraphrased as a belief that once an inventor discovers that a certain cation had antistat properties, any counter ion would be expected to work with that cation to yield effective antistatic properties.

This is not true. Cations and anions that are separately known to be useful in conductive and ionic in compounds, e.g., as surfactants, cannot be assumed to be useful together in

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compounds as antistats. That the suggested assumption is incorrect is established by the data shown in Table 5 of the application.

Example 1 and Comparative Example C3 contain the same cation, i.e., ETHOQUAD™ 18/25. The compounds in Example 1 and Comparative Example C3 are each capable of taking a charge in the testing protocol, yet they exhibit substantially different decay rates. Example 1 drains its charge in less than 1 second while Example C3 retains over 10% of its initial charge after 60 seconds. The slow charge decay of the compound in Example C3 makes it unsuitable for use as an antistat. Thus, in one case, a compound containing ETHOQUAD™ 18/25 as a cation is useful as an antistat and a compound containing the same cation but a different counter anion is not useful as an antistat. In The Federal Test method Standard 10113, Method 4046 which was used to evaluate these materials, any material that drains the initial charge in less than 2.0 sec to 10% of initial values is an effective antistat.

Similarly, although Example 2 and Comparative Example C2 contain the cation ETHOQUAD™ 25 and each is capable of taking a charge in the testing protocol, they exhibit substantially different decay rates. The compound of Example 2 drained its charge in less than 1 second while the Example C2 retained over 10% of its initial charge after 60 seconds. Again the slow rate for C2 makes it unsuitable for use as an antistat. In one case, a compound containing ETHOQUAD™ 25 as a cation is useful as an antistat and a compound containing the same cation but a different counter anion is not useful as an antistat.

Accordingly, one skilled in the art would not conclude from the disclosure of any of the three references, taken either alone or in any combination, that the compounds claimed in the instant claims are effective as antistats. The subject matter of the claims is unobvious.

For these reasons, Applicants respectfully submit that the rejection under 35 USC §103(a) has been overcome and should be withdrawn.

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CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance.
Allowance of claims 1-4, 6, 9-11, and 13, as amended, is solicited.

Respectfully submitted,

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Date

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